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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/587,971	06/06/00	CHERUKURI	S 24222

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IM52/0809

EXAMINER

PRATT, H

ART UNIT

PAPER NUMBER

1761

DATE MAILED:

08/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/587,971

Applicant(s)

CHERUKURI, SUBRAMAN RAO

Examiner

Helen F. Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 15-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 9, 11 and 19, 20, 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 and 19 are indefinite in the use of the ingredients in the group consisting of and non-herbal ingredients . All the ingredients in the group are food additives, which is one of the items in the group. Also, it is not known what is meant by the phrase non-herbal ingredients . Claim 9 is indefinite in the use of the phrase said compressible material is selected from the groups of sugar, fiber, polyols and mineral salts consisting of and mixtures thereof. Claim 20 has the same problem. The cited phrase is not understood. Also, in claims 9 and 20, there is no specific listing of the type of fiber required. In claims 11 and 22 in the Markush grouping from the group consisting of fats .. waxes. Waxes are considered to be part of the wide group of fats. Therefore, the use of the term fat overlaps with the term wax and using both terms is considered to be redundant. Claim 24 is indefinite in the use of the phrases a food item , and a confectionery product . Confectionery products are considered to be foods, therefore the phrases overlap and are redundant.

### ***Claim Rejections - 35 USC 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 14, 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fielden.

Fielden discloses a composition containing the claimed materials (col. 9, lines 40-65 and col. 10, lines 25-34, col. 16, lines 61-70). Claim 1 differs from the reference in the length of the caplet. However, the diameter is given so that it is assumed that the length would be the same. Therefore, it would have been obvious to make a caplet containing the claimed ingredients in the particular size.

Claims 2 -5 further requires the addition of flavors in particular amounts. . . Fielden discloses up to 5 % flavorant in the composition (col. 9, lines 32-36). Therefore, it would have been obvious to use particular amounts of flavors in the claimed composition.

Sweeteners are disclosed in col. 9, lines 37-44 as in claim 6. Claim 7 requires sweeteners or a blend that are equivalent to a teaspoon of sugar. This is seen as within the skill of the ordinary worker because the reference discloses various amounts of different sweeteners including up to 85 % sucrose (col. 9, lines 36-44). Therefore, it would have been obvious to use particular sweeteners at a potency as claimed.

Coatings as in claim 8 are disclosed in col. 17, lines 1-19, compressible sugar and xylitol, as in claim 9, in col. 8, lines 48-50, sorbitol as in claim 10, col. 8, lines 50-

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51, Lubricating material as in claim 11, in col. 9, lines 1-14. Therefore, it would have been obvious to use known materials in the composition.

Claim 12 further requires that the diameter is 3 mm and length is 3 mm.

However, as it is known how to make various sizes of caplets, it would have been within the skill of the ordinary worker to use a particular size. Therefore, it would have been obvious to make the product a particular size.

Claim 13 requires that the product provides controlled release of the active ingredient. The product is seen to be a controlled release composition as the composition has been disclosed above. Therefore, it would have been obvious to make a controlled release product using the claimed composition.

Claim 14 is to the method. Fielden discloses making a process of dry mixing all the ingredients, adding a lubricating material, i. e. aqueous alcohol to form a granulation solution, mixing and drying the granules, then compressing to make caplets in the diameter of 8.6 mm (col. 15, lines 60-67 and col. 16, lines 1-68). Claim 14 differs from the reference in the particular size of the caplet. However, no patentable distinction is seen in 8.6 mm and 7 mm at this time absent a showing of unexpected results using a slightly smaller size. Therefore, it would have been obvious to make a caplet at about the claimed size.

The further limitations of claims 19-23 have been discussed above and are obvious for those reasons.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuri et al. (4,981,698).

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Claim 24 further requires adding two encapsulated flavor ingredients to a food product. Cherukuri et al disclose adding encapsulated sweeteners to chewing gums, confections, baked items, and pharmaceuticals (abstract and col. 20, lines 29-32). Nothing new or unobvious is seen in adding two encapsulated flavor ingredients to a food for their known functions especially since they are encapsulated and so one ingredient would not affect other encapsulated ingredients.

***Allowable Subject Matter***

Claims 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

Hp 8-6-01

*H. Pratt*  
HELEN PRATT  
PRIMARY EXAMINER